

REMARKS

The Office Action mailed April 30, 2004 has been received and carefully considered.

Upon entry of the present amendment, claims 1-13, 45-47 and 49-52 will be currently pending in the application. Claims 1-4, 6, 9, 45, 47 and 49-50 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,386,308 to Michel et al. ("Michel") in view of U.S. Patent No. 5,615,588 to Gottschald ("Gottschald"). Claims 5, 7-8, 10-13, and 46 stand rejected under 35 U.S.C. § 103(a) as being obvious over Michel and Gottschald in further view of U.S. Patent No. 5,359,444 to Piosenka et al. ("Piosenka").

Applicants note that the Office Action did not contain a Form PTO 892 nor did the Office Action identify Michel by its reference number. Applicants' undersigned representative spoke with the Examiner on May 5, 2004, in which the Examiner indicated that a Form PTO 892 was inadvertently omitted and that "Michel" referred to U.S. Patent No. 5,386,308 as identified above. Applicants thank the Examiner for this clarification.

The double patenting rejection and the rejection under 35 U.S.C. § 102(e) in the previous application have been withdrawn. The Examiner states that the arguments made with respect to the rejection under 35 U.S.C. § 103(a) have been considered, but are moot in light of the new ground of rejections using Michel as a reference. *See* Office Action at pg. 7.

I. Amendments to the Claims.

Claims 1, 4-6, 13, 45, and 49 have been amended. New claims 51 and 52 have been added. Support for the amendments is found throughout the specification as originally filed and the amendments present no new matter.

II. Rejection under 35 U.S.C. 103(a).

Claims 1-4, 6, 9, 45, 47 and 49-50 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Michel in view of Gottschald. Claims 5, 7-8, 10-13, and 46 stand rejected under 35 U.S.C. § 103(a) as being obvious over Michel and Gottschald in further view of Piosenka. Applicants respectfully traverse these rejections.

Michel is directed to a weapon aiming device that includes a pair of goggles having a display screen. The lenses of the goggles are at least three successive layers. *See* Michel, col. 2, lines 5-7, and Fig. 1. The first layer (10) is a display screen made from a liquid crystal material confined between two polymer films or liquid crystals dispersed in a polymer matrix. Each surface of the first layer is attached to an array of electrodes. The second layer (20) is a thickness layer having a refractive index equal to the first layer and the matrix of the third layer. The third layer (30) is a formable polymer consisting of a matrix of regularly spaced micro-cavities filled with a liquid (37). The liquid has two refractive indices depending on the value of an electric field applied across it and permits the collimation of specific points of the display screen layer. *See* Michel col. 2, lines 5-40.

Gottschald teaches an apparatus for processing the edge of ophthalmic lenses. The Patent Office has asserted that it would have been obvious to use the apparatus of Gottschald with the lens taught by Michel to arrive at Applicants' claimed invention.

Contrary to the Patent Office's assertion, it would not be obvious to combine the disclosure of Michel with Gottschald to arrive at Applicants' claimed invention. Michel does not teach, disclose or suggest a lens that includes an electro-active refractive matrix that is capable of altering an optical power of the optical lens system, much less modifying or configuring the edge

of the disclosed lens to fit within a specific eyeglass frame without removing a portion of the electro-active refractive matrix that alters the optical power of the lens system.

First, it is not apparent from the disclosure of Michel that the disclosed lens can be edged to fit within any particular frame. In fact, the goggle frame of Michel is described with particular specificity: "The frame **60** of the goggles looks like the frame of a pair of safety goggles, half way between welder's goggles, and a diver's face-mask or skiing goggles." Michel, col. 8, lines 6-8. This suggests that the lens of Michel is specially designed to fit within the specifically described goggle frame and that it could not be edged to fit within any eyeglass frame.

Second, Michel does not teach an electro-active refractive matrix that alters the optical power of the lens system to provide vision correction. At most, the microlenses in the third layer make the screen of the first layer visible to the goggle wearer while the wearer's vision remains focused at infinity; i.e., the wearer using Michel's weapon system can see a cross hair on the goggles' display screen while viewing the target. *See* Michel, col. 3, lines 48-57. There is no suggestion in Michel that the lens described therein has an electro-active refractive matrix capable of altering the optical power of the optical system.

Third, the matrices of the first and third polymer layers of Michel's lens extend all the way to the edge of the lens. While the areas of liquid electro-optic material and the liquid-crystals of these layers can be dispersed in cavities within the polymer, even if one attempted to edge the lens in Michel, at least some of the liquid electro-optic material and/or liquid crystal material would still drain from the lens. Thus, one of ordinary skill in the art would not be motivated to modify the lens of Michel with Gottschald's edging apparatus given the unknown effect on its operability by removing liquid material from the lens. Conversely, in Applicants'

claimed invention, the lens can be edged to fit within a particular eyeglass frame without removing a portion of the electro-active matrix that provides vision correction by altering the optical power of the lens system.

Applicants' claimed invention includes an electro-active lens that provides vision correction and that can be modified to fit into an eyeglass frame without removing any portion of the electro-active matrix that alters the optical power of the lens system. Applicants' contribution represents a substantial achievement over the prior art. As described at pages 19-20 of the Application as originally filed, by providing a lens from which material can be removed to fit within a particular eyeglass frame, while still retaining the electro-active matrix which provides vision correction, Applicants have achieved an invention which greatly reduces the number of on-hand inventory needed to produce a spectacle lens for almost any given prescription from as many as 5,239,080 lens blanks to 1619 or fewer.

Accordingly, even assuming, *arguendo*, that one of skill in the art tried to combine Michel with Gottschald, Applicants have already demonstrated how their achievement resolves a long-felt need. As noted above, the ability to reduce an inventory of over five million lenses to 3/100 of one percent of that amount or lower, would provide a high motivation for those in the art. However, the invention was not achieved until Applicants' claimed invention, which has a priority date nearly five years after Michel issued. Were Applicants' claimed invention really obvious as alleged by the Examiner, there is good reason to believe it would not have taken such a long time to achieve what the Examiner appears to contend is a relatively simple combination of taking Michel's lens and edging it.

Accordingly, Michel and Gottschald, alone or in combination, do not teach, disclose, or suggest each and every limitation of the claimed invention. The addition of Piosenka does not resolve the deficiencies as explained in Applicants' prior response. In light of at least these differences versus the cited art and further in view of the long felt need solved by Applicants' claimed invention, the rejection should be withdrawn.

CONCLUSION

For at least the reasons stated above, claims 1-8, 10-13, 45-47, and 49-52 are in condition for allowance. Accordingly, Applicants respectfully request that upon entry of the preceding amendments, the Application be allowed and passed to issue.

In the event any outstanding issues remain, Applicants would appreciate the courtesy of a telephone call to Applicants' undersigned representative to resolve such issues in an expeditious manner.

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